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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,212	01/22/2002	Yasuo Nomura	275791US6	4641
22850	7590	07/26/2006	EXAMINER	
C. IRVIN MCCLELLAND OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				WENDMAGEGN, GIRUMSEW
		ART UNIT		PAPER NUMBER
		2633		

DATE MAILED: 07/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/054,212	NOMURA, YASUO	
	Examiner	Art Unit	
	Girumsew Wendmagegn	2633	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 01/22/2002.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-7 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-7 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 22 January 2002 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>06/13/2006</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

- ❖ **Claim6** are rejected under 35 U.S.C. 102(e) as being anticipated by Saeki et al. (Patent number US 6,078,727).
- ❖ **Claim6** drawn to a program storage medium and a computer readable program in which a computer readable program for encoding inputted AV signals to produce coded data and recording the coded data onto a randomly accessible recording medium and for playing back and decoding the coded data recorded on the recording medium.

 - Saeki et al. teaches a computer program storage medium in which a computer readable program embodied on it (see claim 21).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton et al. (Patent number US 6,233,389) and Seo (Patent number US 6798980).

- ❖ **Claim1–4** drawn to a recording and playback apparatus for first encoding input AV signals to produce coded data and recording the coded data onto a randomly accessible recording medium and for playing back and decoding the coded data recorded on the recording medium. Converting the first coded data to second coded data. The first coding system is the MPEG2 system and the second Coding is MPEG1 system. A transfer means for transferring one of the coded data to another electronic equipment.
- ❖ **Claim5** drawn to a recording and playback method for recording and playback apparatus, which encodes inputted AV signals to produce coded data and records the coded data onto a randomly accessible recording medium and further plays back and decodes the coded data recorded on the recording medium comprising: a production step; First recording step; supper vision step; readout step; conversion step; second recording step and the process of the readout step.

- Barton et al. teaches a recording and playback apparatus and method for first encoding inputted AV signals to produce coded data and recording the coded data onto a randomly accessible recording medium and for playing back and decoding the coded data recorded on the recording medium (See figure 1 and column 3 line 30-67, column 4 line 1-14, claim 32) but does not teach converting the first coded data in to the second coded data and for transferring one of the coded data to another electronic equipment. However, Seo teaches converting the first coded data (MPEG2) to the second coded data (MPEG1)(See column 3 line 33-39).
- ❖ One of ordinary skill in the art at the time the invention was made would have been motivated to incorporate the conversion means of Seo to Barton et al. System because MPEG1 is low bit rate and takes less space in storage medium than MPEG2 (see Column 5 line 38-45).

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, absent unexpected results to the contrary.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

❖ **Claim 7** drawn to a program for causing a computer, which encodes inputted AV, signals to produce coded data and records a coded data onto a randomly accessible recording medium and further plays back and decodes a coded data recorded on the recording medium.

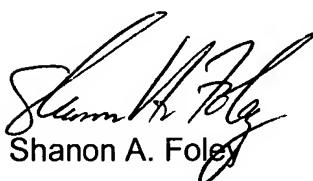
➤ Computer program without the computer-readable medium is nonstatutory functional descriptive material. Descriptive material are nonstatutory when claimed as descriptive material per se. Functional descriptive material claimed without in combination with an appropriate computer readable medium to enable the functionality to be realized is not patent eligible subject matter (Warmer dam, 33F.3d at 1360, 31 USPQ2d at 1759). This subject matter is not limited to that which falls within a statutory category of invention because it is not limited to a process, machine, manufacture, or a composition of matter. A machine, a manufacture and composition of matter all define things or products while a process is a series of steps or acts to be performed. And the claim does not fall within any one of these categories.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Girumsew Wendmagegn whose telephone number is 571-270-1118. The examiner can normally be reached on 7:30-5:00, M-F, alternate Friday off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shanon Foley can be reached on 571-272-0898. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Shanon A. Foley

Supervisory Patent Examiner


Girumsew Wendmagegn